

AMENDMENTS TO THE DRAWINGS

The attached sheets of drawings include changes to Figs. 1-3b and 6. These sheets, replace the original sheets for Figs. 1-3b and 6. In Figs 1-3b, the label "CONVENTIONAL ART" has been added. In Fig. 6, duplicate references have been eliminated. Attached are both replacement sheets and annotated sheets showing the drawing changes.

Attachments: Annotated Sheets
Replacement Sheets

REMARKS/ARGUMENTS

The Applicants thank the Examiner for the thorough consideration given the present application. Claims 1-4 and 6-14 are pending in the present application. In this Amendment, claims 1, 10 and 11 have been amended. The Examiner is respectfully requested to reconsider the rejections of claims 1-4 and 6-14 in view of the amendments to the specification, claims and the remarks as set forth below.

Claim for Priority

It is gratefully acknowledged that the Examiner has recognized the Applicants' claim for foreign priority. As suggested by the Examiner, the Applicants have amended the first page of the specification to refer to the corresponding International Application filed by the Applicants. In view of the fact that Applicants' claim for priority has been acknowledged, no additional action is required from the Applicants at this time.

Acknowledgment of Information Disclosure Statement

The Examiner has acknowledged the Information Disclosure Statement filed on April 14, 2004. An initialed copy of the PTO-1449 has been received from the Examiner. No further action is necessary at this time.

Amendments to the Drawings

The Examiner has objected to the drawings, and the drawings have been amended, as described above and as shown in the attached Replacement Sheets and Annotated Sheets of drawings.

Objections to the Specification

The Examiner has objected to the specification. The specification has been amended substantially in accordance with the Examiner's suggestions. The Applicants, however, respectfully traverse the objection to Table 1 on page 13. It is respectfully submitted that those skilled in the art reading Table 1 would recognize and understand that the commas, which are conventionally used in Europe, are equivalent to periods, which are conventionally used in the United States. Accordingly, the Examiner is respectfully requested to withdraw the objections to the specification.

Objections to the Claims

The Examiner has objected to the claims. The claims have been amended substantially in accordance with the Examiner's suggestions. Accordingly, the Examiner is respectfully requested to withdraw the objections to the claims.

Rejection Under 35 U.S.C. § 101

The Examiner has rejected claims 11-14 under the provisions of 35 U.S.C. § 101 as being directed to non-statutory subject matter. Accordingly, claim 11 has been amended to recite "passing a flow of air". It is respectfully submitted that claim 11 is a method claim and the act of "passing a flow of air" is statutory subject matter. Accordingly, the Examiner is respectfully requested to withdraw the rejection based upon the provisions of 35 U.S.C. § 101.

Rejection Under 35 U.S.C. § 112

The Examiner has rejected claims 1-4 and 6-14 under the provisions of 35 U.S.C. § 112, first paragraph, as being failing to comply with the written description requirement. Applicants respectfully traverse the rejection.

To satisfy the written description requirement, a patent specification must describe the claimed invention in sufficient detail that one skilled in the art can reasonably conclude that the inventor had possession of the claimed invention. See, e.g., *Moba, B.V. v. Diamond Automation, Inc.*, 325 F.3d 1306, 1319, 66 USPQ2d 1429, 1438 (Fed. Cir. 2003); *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d at 1563, 19 USPQ2d at 1116. The examiner has the initial burden, after a thorough reading and evaluation of the content of the application, of presenting evidence or reasons why a person skilled in the art would not recognize that the written description of the invention provides support for the claims. There is a strong presumption that an adequate written description of the

claimed invention is present in the specification as filed, *Wertheim*, 541 F.2d at 262, 191 USPQ at 96. "Consequently, rejection of an original claim for lack of written description should be rare." (See, MPEP § 2163 Guidelines for the Examination of Patent Applications Under the 35 U.S.C. 112, para. 1, "Written Description" Requirement).

International Patent Application WO 99/21263 clearly includes original claims 56-59 directed to the air filter and filtered air. Accordingly, the Applicants respectfully submit that ***there is explicit support for the air filter and the filtered air embodiment of claims 1-4 and 6-14*** in original claims 56-59 of the International Application and on page 25 of the specification. Moreover, even if there is no explicit support, which is not the case, the Applicants can still comply with the written description requirement, if the claims are *implicitly or inherently* supported in the originally filed disclosure.

When an explicit limitation in a claim "is not present in the written description whose benefit is sought it must be shown that a person of ordinary skill would have understood, at the time the patent application was filed, that the description requires that limitation." *Hyatt v. Boone*, 146 F.3d 1348, 1353, 47 USPQ2d 1128, 1131 (Fed. Cir. 1998). See also *In re Wright*, 866 F.2d 422, 425, 9 USPQ2d 1649, 1651 (Fed. Cir. 1989); *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) ("To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. ") (citations omitted). In addition to the explicit support provided in the specification, it is respectfully submitted that one

skilled in the art would either implicitly or inherently know to use an air filter with a thermal engine of a hybrid vehicle.

For all of these reasons, the Applicants respectfully submit the written description requirement for claims 1-4 and 6-14 has been met, and the Examiner is respectfully requested to withdraw the rejection.

Conclusion


In view of the above amendments and remarks, it is believed that the claims clearly distinguish over the patents relied on by the Examiner, either alone or in combination.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Richard J. McGrath (Reg. No. 29,195) at the telephone number of (703) 205-8000, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

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Respectfully submitted,

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Attachments: Annotated Sheets of Drawings
Replacement Sheets of Drawings

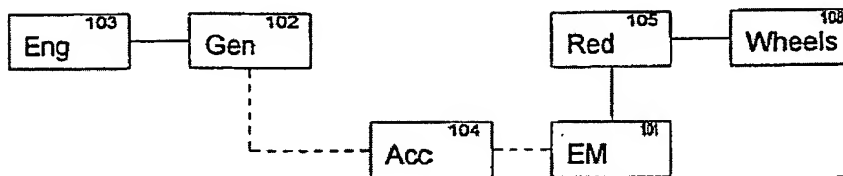


Fig 1

CONVENTIONAL ART

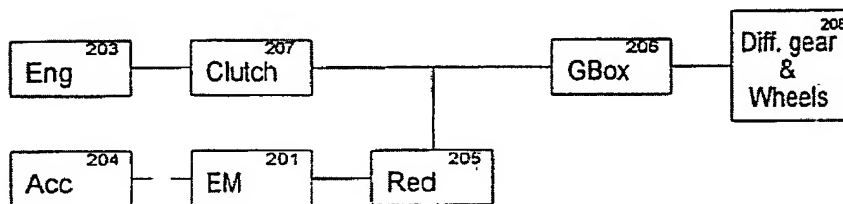


Fig 2

CONVENTIONAL ART

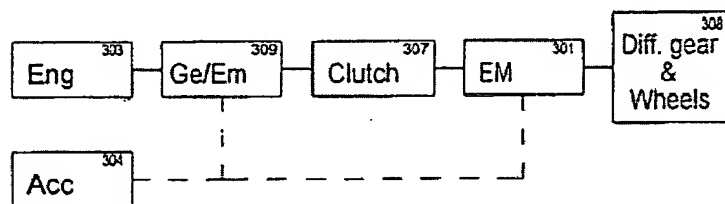


Fig 3a

CONVENTIONAL ART

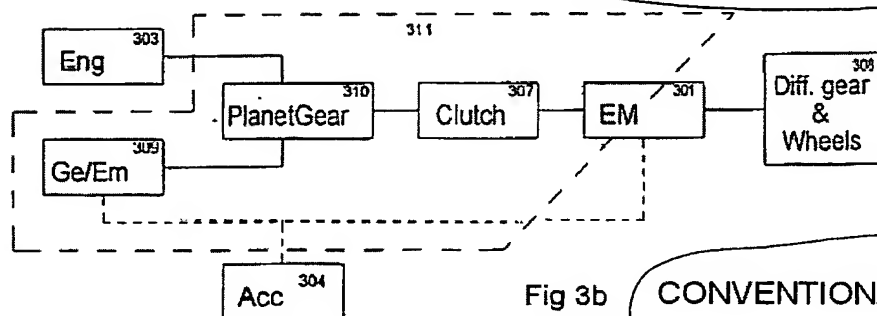


Fig 3b

CONVENTIONAL ART

Label Added

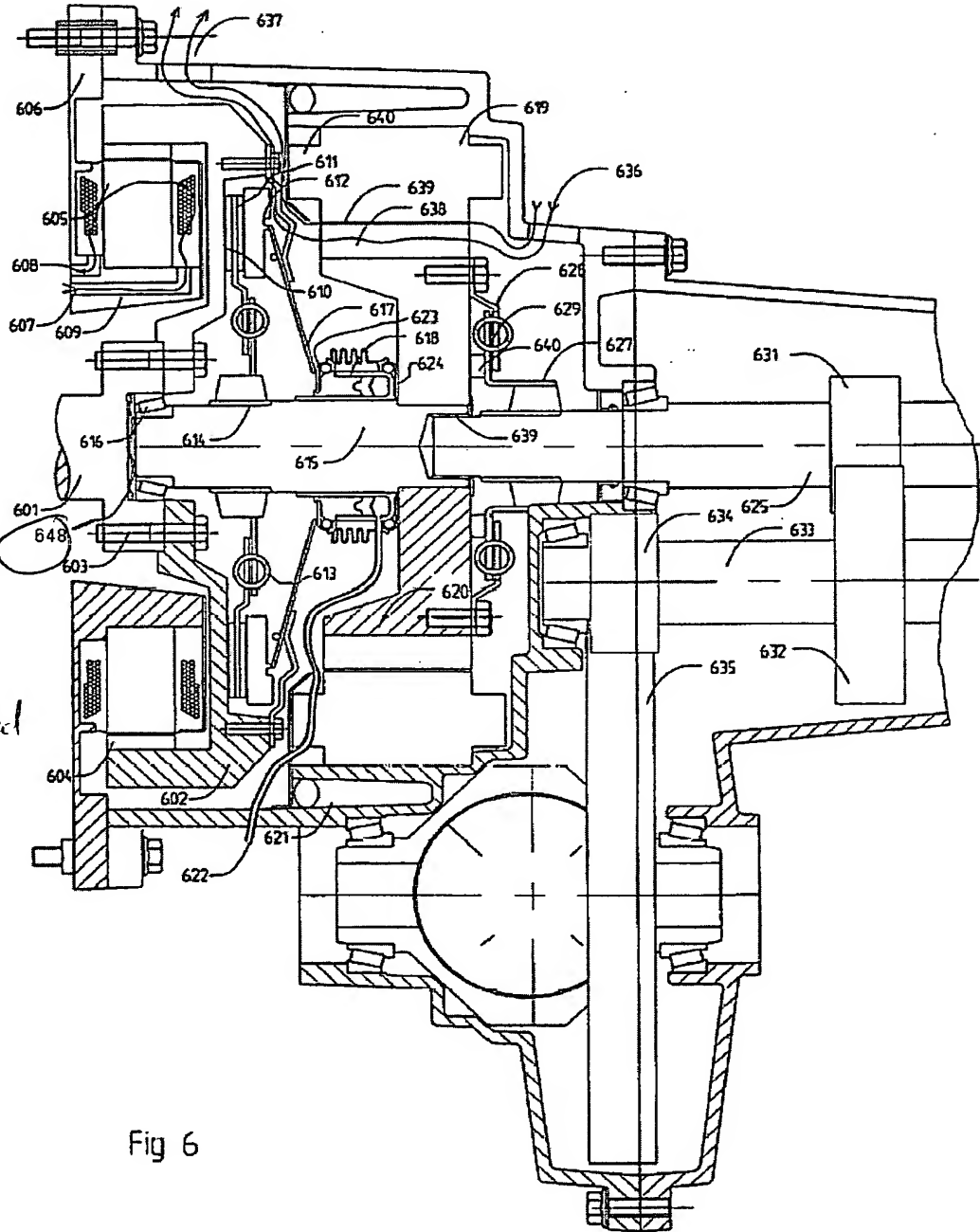


Fig 6